

Notice of Allowability	Application No.	Applicant(s)	
	10/687,164	LEE ET AL.	
	Examiner	Art Unit	
	Zinna Northington Davis	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment filed September 6, 2005 and IDS filed November 7, 2005.
2. ☒ The allowed claim(s) is/are 1-6 and 18, (now renumbered as 1-7, respectively).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 11/05 | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ms. Gabryleda Ferrari-Dileo on November 28, 2005.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 1-3, 12, and 18, drawn to a chemical compound and pharmaceutical composition of formula (I) wherein A is aryl.

Group II: Claims 1-4, and 18, drawn to a chemical compound and pharmaceutical composition of formula (I) wherein A is imidazolyl.

Group III: Claims 1-6, and 18, drawn to a chemical compound and pharmaceutical composition of formula (I) wherein A is isoxazolyl, isothiazolyl, oxadiazolyl, oxazolyl, pyridinyl, pyridazinyl, pyrimidinyl, pyrazinyl, pyrazolyl, pyrrolyl, thiazolyl or thienyl.

Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions within the definition of A are independent and patentably distinct. A prior art reference which anticipate an A radical such as phenyl under 35 U.S.C. 102 would not render obvious another member such as imidazolyl. See

Reference N which teach imidazoline compounds are useful in the treatment of diabetes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Ms. Gabriella Ferrari-Dileo on November 28, 2005 a provisional election was made *without* traverse to prosecute the invention of Group III, claims 1-6 and 18. Claims drawn to Groups I and II are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. The application has been amended as follows:

A. Claim 12 has been canceled.

B. At claim 1, lines 4 and 5, the radical A has been amended in favor of:

--A is isoxazolyl, isothiazolyl, oxadiazolyl, oxazolyl, pyridinyl, pyridazinyl, pyrimidinyl, pyrazinyl, pyrazolyl, pyrrolyl, thiazolyl or thienyl.--

C. At claims 2 and 3, lines 2 and 3, the radical A has been amended in favor of:

--A is isoxazolyl, isothiazolyl, oxadiazolyl, oxazolyl, pyridinyl, pyridazinyl, pyrimidinyl, pyrazinyl, pyrazolyl, pyrrolyl, thiazolyl or thienyl.--

D. Claim 4 has been amended in favor of:

--4. (currently amended) The compound according to claim 3 that is

N-(4-tert-butylphenyl)-4-(2-pyridinyl)benzamide;

-(4-tert-butylphenyl)-4-(3-nitro-2-pyridinyl)benzamide;

Art Unit: 1625

4-(3-amino-2-pyridinyl)-N-(4-tert-butylphenyl)benzamide;
4-[3-(acetylamino)-2-pyridinyl]-N-(4-tert-butylphenyl)benzamide;
N-(4-tert-butylphenyl)-4-(1,3-thiazol-2-yl)benzamide;
N-(4-tert-butylphenyl)-4-(2-pyrimidinyl)benzamide;
N-(4-tert-butylphenyl)-4-(3-cyano-2-pyridinyl)benzamide;
N-(4-tert-butylphenyl)-4-(2-thienyl)benzamide;
4-{3-[acetyl(methylsulfonyl)amino]-2-pyridinyl}-N-(4-tert-butylphenyl)benzamide;
4-(6-bromo-2-pyridinyl)-N-(4-tert-butylphenyl)benzamide;
ethyl 2-(4-[[4-(4-tert-butylphenyl)amino]carbonyl]phenyl)-3-pyridinylcarbamate;
4-(3-{bis[(chloromethyl)sulfonyl]amino}-2-pyridinyl)-N-(4-tert-butylphenyl)benzamide;
N-(4-tert-butylphenyl)-4-(2-pyridinyl)benzenesulfonamide;
N-(4-tert-butylphenyl)-4-(1H-pyrazol-1-yl)benzamide;
N-(4-tert-butylphenyl)-4-(3-pyridinyl)benzamide;
N-(4-tert-butylphenyl)-6-(1H-pyrazol-1-yl)nicotinamide;
N-(4-tert-butylphenyl)-4-(4-pyridinyl)benzamide;
N-(4-tert-butylphenyl)-4-(1,3-oxazol-2-yl)benzamide;
N-(4-tert-butylphenyl)-4-(3-chloro-2-pyridinyl)benzamide;
4-(3-chloro-2-pyridinyl)-N-(3-methylphenyl)benzamide;
4-(3-chloro-2-pyridinyl)-N-(4-methylphenyl)benzamide;

Art Unit: 1625

4-(3-chloro-2-pyridinyl)-N-(4-methoxyphenyl)benzamide;
4-(3-chloro-2-pyridinyl)-N-[3-(trifluoromethoxy)phenyl]benzamide;
4-(3-chloro-2-pyridinyl)-N-(3,4-dimethylphenyl)benzamide;
4-(3-chloro-2-pyridinyl)-N-(4-ethylphenyl)benzamide;
4-(3-chloro-2-pyridinyl)-N-(4-isopropylphenyl)benzamide;
N-(4-tert-butylphenyl)-4-[5-(trifluoromethyl)-1H-pyrazol-1-yl]benzamide;
N-[4-(trifluoromethyl)phenyl]-4-[5-(trifluoromethyl)-1H-pyrazol-1-yl]benzamide;
N-(4-tert-butylphenyl)-4-(3-isoxazolyl)benzamide; or
N-(4-tert-butylphenyl)-4-(3-fluoro-2-pyridinyl)benzamide.--.

E. Claim 18 has been amended in favor of:

--18. (Original) A pharmaceutical composition comprising a therapeutically effective amount of a compound according to claim 1 or a pharmaceutically acceptable salt thereof.--.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

5. Applicants preserve the right to file divisional applications drawn to the non-elected subject matter.
6. The claims have been amended to the elected subject matter. The non-elected subject matter has been cancelled.
7. Claim 18 has been amended to depend upon claim 1.

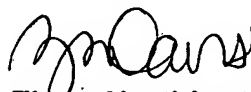
Art Unit: 1625

8. The Information Disclosure Statement filed November 7, 2005 has been considered. The references alone or in combination forms do not teach nor suggest the invention as instantly claimed. Accordingly, the claims are allowed.

9. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is 571-272-0682.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Zinna Northington Davis
Primary Examiner
Group 1600-AU 1625